REMARKS

This responds to the Office Action mailed on September 13, 2007.

Claims 1, 3, 6-11, 19-23, 25 and 28 are amended, claims 2, 12-18 have been previously canceled, and no claims are added; as a result, claims 1, 3-11 and 19-30 remain pending in this application.

§112 Rejection of the Claims

Claims 8-11 and 19-20 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. In particular, the Office Action asserted that the term "tangible" renders the scope of the claim undeterminable. Without agreeing to statement in the Office Action and in order to expedite prosecution, Applicant has amended the claims to remove "tangible" and to clarify that the media is a computer-readable storage medium. Applicant respectfully submits that a computer-readable storage medium does not include signals because while signals transmit instructions and/or data, signals do not store instructions or data. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 8-11 and 19-20.

§103 Rejection of the Claims

Claims 1, 3-11, 19-20 and 25-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Emens et al (U.S. 6,606,643, hereinafter "Emens") in view of Ramanathan et al (U.S. 5,913,041, hereinafter "Ramanathan"). The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *See Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1336-37 (Fed.Cir. 2005). The legal conclusion that a claim is obvious within § 103(a) depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966). The underlying factual issues set forth in *Graham* are as follows: (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested, by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) ; M.P.E.P. § 2143.03. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ; M.P.E.P. § 2143.03. As part of establishing a *prima facie* case of obviousness, the Examiner's analysis must show that some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.* To facilitate review, this analysis should be made explicit. *KSR Int'l v. Teleflex Inc., et al.*, 127 S.Ct. 1727; 167 L.Ed 2d 705; 82 USPQ2d 1385 (2007) (citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)).

Applicant has amended claims 1, 8, 25 and 28 such that the claims now recite determining a type of empirical measurement from a plurality of types, where the type is selected according to the size of data to be obtained. The claims also recite using an empirical measurement of the selected type to determine which source to use to download data. Applicant has reviewed Emens and Ramanathan, and can find no teaching or suggestion of selecting a type of measurement to use based on a data size, and then selecting a source using an empirical measurement having the selected type. As a result, independent claims 1, 8, 25 and 28 recite elements not found in the combination of Emens and Ramanathan thus providing patentable differences between the cited art and the claims at issue. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 1, 8, 25 and 28.

Claims 21-24 and 30 were rejected under 35 USC § 103(a) as being unpatentable over Emens and Ramanathan in view of Andrews et al. (US 2002/0038360). Independent claim 21, similarly to claims 1, 8, 25 and 28 has been amended to recite selecting a type of empirical measurement based a predetermined file size and the selecting download source based on an empirical measurement of performance having the selected type. As discussed above, neither Emens nor Ramanathan teach or suggest the recited language. Further, Applicant has reviewed Andrews and can find no teaching or suggestion of the recited language. As a result, the

combination of Emens, Ramanathan and Andrews fails to teach or suggest each and every element of Applicant's claim 21, thereby providing differences between the cited art and the claims at issue. Thus claim 21 is not obvious in view of the combination of Emens, Ramanathan and Andrews. Applicant respectfully requests reconsideration and the withdrawal of the rejection.

With respect to dependent claims 3-7, 9-11, 19-20, 22-24, 26-27, and 29-30, in addition to the patentable elements provided by the dependent claims, the dependent claims are believed allowable by virtue of their dependency on an allowable base claim. Accordingly, the rejections of the dependent claims based on the combination of Emens and Ramanathan and the combination of Emens, Ramanathan and Andrews is believed overcome. Applicant respectfully requests reconsideration and the withdrawal of the rejections of claims 3-7, 9-11, 19-20, 22-24, 26-27, and 29-30.

Reservation of Rights

In the interest of clarity and brevity, Applicant may not have equally addressed every assertion made in the Office Action, however, this does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present

patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 373-6954 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date March 13, 2008 By _____
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CERTIFICATE UNDER 37 CFR § 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 13 day of March, 2008.

Rodney L. Lacy _____

Name Signature